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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/572,804

08/24/2006

Jerzy A. Bajgrowicz

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11/25/2008

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EXAMINER

ASDJODI, MOHAMMAD REZA

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

11/25/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/572,804	<b>Applicant(s)</b> BAJGROWICZ, JERZY A.	
	<b>Examiner</b> MOHAMMAD R. ASDJODI	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

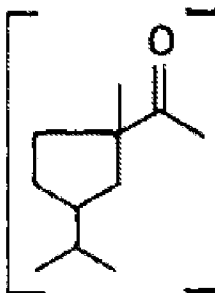
**DETAILED ACTION*****Claim Rejections - 35 USC § 102***

*The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:*

***A person shall be entitled to a patent unless –  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.***

Claims 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Settine et al. (Journal of Organic Chemistry 1964, 29(3), 616-18).

Regarding claims 9-10, Settine et al. teach synthesis of a fragrant composition from Florida orange oil (Valencia) with the chemical structure below, wherein R<sup>1</sup> = methyl, and R<sup>2</sup> with R<sup>3</sup> make a carbonyl group together; [page 617].

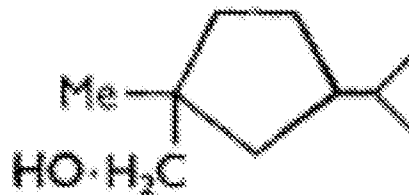


Claim 9 is rejected under 35 U.S.C. 102(b) as being anticipated by Allan et al. (University of Glasgow, UK, Journal of Chemical Society (1959), 2186-92).

Regarding claim 9, Allan et al. teach a method of preparing 1-methyl-3-

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isopropyl cyclopentyl wherein  $R^1 = R^2 = H$ , and  $R^3 = OH$ , as shown in structure below.



With respect to distinct enantiomer structures (*R* and *S*) it is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. *In re Swinehart et al.*, 169 USPQ 226 at 229. Since both Settine et al. and Allan et al. reference teach all of the applicant's claimed compositional (structural) limitations, it is inherent that the reference article function in the same manner claimed by applicant. Chemical production or yield for optical isomers (or enantiomers) is an inherent properties of reactions. The burden is upon applicant to prove that the subject matter shown to be in prior art does not possess the characteristic relied on, [MPEP 2112.01, II].

### **Rejections - 35 USC § 103**

*The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:*

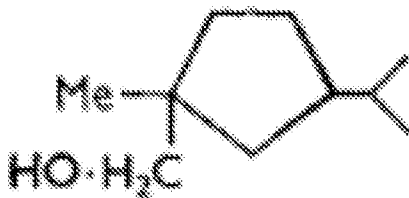
**(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.**

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over as Allan et al. (University of Glasgow, UK, Journal of Chemical Society (1959), 2186-92, in view of Habib-Emil Eschinazi (US 2,946,823).

Regarding claims 8-9, Allan et al. teach a method of preparing 1-methyl-3-isopropyl cyclopentyl wherein  $R^1 = R^2 = H$ , and  $R^3 = OH$ , as shown in structure below.



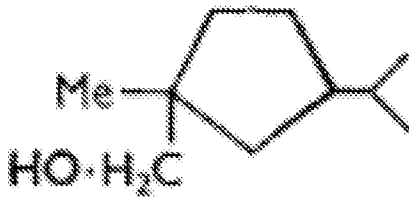
Allen et al. do not teach its fragrance application. However, Habib-Emil Eschinazi teach a homolog structure of 1-methyl-3-isopropyl cyclopentyl having desirable olfactory characteristics and is used as fragrance in base material such as soaps; [2: 18-28, 4: 41]. Habib-Emil and Allan are analogous art, that of

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chemical structure synthesis methyl-isopropyl cyclopentyls. At the time of invention it would have been obvious to a person of ordinary skill in the art to utilize Habib-Emil 's application for Allan's 1-methyl-3-isoprpyl cyclopentyl product with the motivation of making a fragrance as evidenced by Habib.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allan et al. (University of Glasgow, UK, Journal of Chemical Society (1959), 2186-92, in view of Habib-Emil Eschinazi (US 2,946,823).

Regarding claims 1-7, Allan et al. teach a method of preparing 1-methyl-3-isoprpyl cyclopentyl wherein  $R^1 = R^2 = H$ , and  $R^3 = OH$ , as shown in structure below.



Regarding claims 1-7, Allen et al. do not teach its fragrance application. However, Habib-Emil Eschinazi teach a homolog structure of 1-methyl-3-isoprpyl cyclopentyl having desirable olfactory characteristics and is used as fragrance in soaps; [2: 18-28, 4: 41]. Habib-Emil and Allan are analogous art, that of chemical structure synthesis methyl-isopropyl cyclopentyls. At the time of invention it would have been obvious to a person of ordinary skill in the art to utilize Habib-Emil 's application for Allan's 1-methyl-3-isoprpyl cyclopentyl product with the motivation of making a fragrance.

The Office realizes that all the claimed effects or physical properties (optical isomerism), such as enantiomerism, are not positively stated by the reference (or: References). However, the reference teaches all of the claimed reagents. Therefore, the claimed effects and physical properties (density of the foam) would implicitly be achieved by a composition with all the claimed ingredients. If it is the applicant's position that this would not be the case: (1) evidence would need to be presented to support applicant's position; and (2) it would be the Office's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties and effects with only the claimed ingredients.

### ***Response to Arguments***

Applicant's arguments filed 10/24/08 have been fully considered but they are not persuasive.

A- In response to applicant's argument that: "Allan is not teaching the incorporation of compound (a fragrance in a base material)": it has been held that a recitation with respect to the manner in which a claimed article, or composition, is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitation. *Ex parte Masham*, 2 USPQ2d 1647 (1987), [MPEP 2114, R-1]. However regarding the amendment claims 8-10 has met new ground of rejection.

B- In response to applicant's argument that in rejections of claim 1-7: "Habib and allan are not combinable because of lack of teaching in Habib for a

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methylation in C-1 position” it should be noted that Habib emphatically teaches the same family of fragrant material as Allan and he also specifically teaches the preparation of Allan’s fragrance (unsaturated ketone methyl-(3-isopropyl-1-cyclopentyl) ketone; [column 2: 1<sup>st</sup> paragraph]).

C- In response to applicant's argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., earthy/mossy, green, woody as opposed to orange blossoms) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. M. Reza Asdjodi whose telephone number is (571)270-3295. The examiner can normally be reached on Monday-Friday 8:00-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Eashoo/  
Supervisory Patent Examiner, Art Unit 1796

/M. R. A./  
Examiner, Art Unit 1796  
11/06/08